

### ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Applicant notes that the Examiner has failed to indicate whether the drawings are acceptable.

Claims 1-29 remain in this application. New claims 30-33 are added without adding any new matter.

Claims 1, 3, 7-10, 12, and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Beck *et al.* (U.S. App. No. 2004/0057591 A1) in view of Kachler *et al.* (U.S. Pat. App. 2002/0082794 A1). Claims 2, 4-6, and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Beck and Kachler in view of Gabara *et al.* (U.S. 7,024,000 B1). Claim 13 was rejected 35 U.S.C. §103(a) as being unpatentable over Beck and Kachler in view of Bye *et al.* (U.S. 2004/0204921 A1). For the following reasons, the rejections are respectfully traversed.

Claim 1 recites a method for adjusting a first hearing device based on adjustments of a second hearing device, the method including the steps of

converting an acoustic test signal into an electric test signal by a  
microphone of the second hearing device;  
converting an acoustic signal generated by a receiver of the second  
hearing device into an electrical signal;  
analyzing the electrical signal in the first hearing device; and  
adjusting the first hearing device based on results obtained in the  
analyzing performed in the first hearing device.

and thus it is the hearing device being *adjusted* that analyzes the electric signal output by the hearing device *not* being adjusted. In contrast, Beck teaches that it is *not* the device being adjusted, but the hearing device that is *outputting* the signal, that determines the signal transit time (see paragraph 0017). Thus, the claim does not read on the Beck reference. Kachler, and the other references, fail to overcome this shortcoming of Beck,

and thus claim 1 along with the claims dependent on claim 1, are patentable over the references.

Similarly, claim 29 recites that the analyzing is being done in an analyzing unit in the hearing device that is being adjusted, and thus claim 29 along with the claims dependent thereon are patentable over the references as well.

Claims 14-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Beck and Kachler and Kates (U.S. Pat. App. 2002/0176584 A1). Claims 15 and 20-27 were rejected as above in further view of Ishige et al. (U.S. 5,910,997). For the following reasons, the rejections are respectfully traversed.

As argued in the previous response, claim 14 recites an apparatus where an “acoustic test signal is fed to a microphone of [a] second hearing device in which *another acoustic signal* is generated that is recorded by [a] measurement microphone of [a] *couple element*, the measurement microphone being operatively connected to [a] first hearing device which is operatively connected to the control unit.”

The Examiner admits that there is no teaching in Beck of any “couple element” including a microphone.. Accordingly, the Examiner cites the measurement microphone of Kates as disclosing such a coupling element including a microphone. However, the measuring microphone 118 found in Kates does not connect to another hearing device, but instead connects to a computer 104. Accordingly, the Examiner cites Ishige Fig. 3 for such a teaching. However, the combination of references fails to teach a coupling element that couples the output of one hearing device with an input of another hearing device, as is required by the claim language. The Examiner appears to be arguing that the Ishige reference teaches three hearing aids 10, 12, and 13, but the reference clearly states that item 12 is a monitor for extracting hearing aid parameters (col. 5, lines 60-61), and that item 13 is an apparatus such as a telephone set, a television set, a radio receiver, or a headphone (see col. 5, lines 22-24). Nevertheless, there is no teaching of any *coupling element* coupling hearing aid 10 to either item 12 *or* item 13. Instead, the reference makes clear that the output of the hearing aid 10 is directly provided to an input of device 12 *or* device 13, without any coupling element being identified (see col. 5, lines 15-22).

Accordingly, none of the cited references teach any coupling element that couples the output of one hearing device with an input of another hearing device, and the

Examiner has failed to explain how the combination can teach that which the references do not teach individually. None of the remaining cited references overcome this shortcoming. Thus, claim 20 and the claims dependent thereon are patentable over the references.

Claim 29 and new claim 31 have limitations similar to those discussed above, and thus are patentable over the references for similar reasons. Finally, the remaining claims depend, directly or indirectly, upon one of the above discussed claims, and thus are patentable over the references for at least the same reasons as their parent claims.

Finally, the Examiner has failed to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.).

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph.)

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness are not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. TSW-36321.

Respectfully submitted,  
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